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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,439	01/19/2001	Robert Betros	DISC1120	7164
30542	7590	08/31/2006		EXAMINER
FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			LIN, KELVIN Y	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,439	BETROS ET AL.	
	Examiner	Art Unit	
	Kelvin Lin	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-21 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Response to Arguments

1. Applicant's arguments, see Remarks from page 8-20, filed on June 16, 2006, with respect to the rejection(s) of claim(s) 1-21 under 35 USC 103(a) as the combination of Rangarajan in view of Pfeiffer have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, Claims 1-21 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Claims 1-21 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or

use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

As to the breadth of the claims, the claims in this application are broad. Essentially all particular implementations for performing two-way asynchronous communication between a client and a server within a single HTTP transaction fall within the scope of the claims. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

As to the state of the prior art, the very features that the applicants argue distinguish the claims from the prior art are those that are not described. A search of the prior art has not disclosed a system as claimed for performing two-way asynchronous communication between a client and a server within a single HTTP transaction. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

As to the level of predictability in the art, the computer arts are generally considered predictable. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *not undue*.

As to the amount of direction provided by the inventor, the applicants' attorney pointed to page 3 lines 12-25, page 6 line 11 to page 7 line 24, and page 8 line 12 to page 9 lines 12 in conjunction with the figures as supporting their amendments to the claims during the telephone interview held on June 15, 2006. During that interview, the inventor, Robert Betros, pointed to the client side logic (Fig. 1 elem. 104) and CGI (Fig. 1 elem. 124) in conjunction with Figures 2 and 4 as what implements the claimed invention. Given the inventor's statement in the interview, a review of the specification's disclosure regarding the client side logic and the CGI is important. The specification describes embodiments of dynamically delivered client side logic as applets and Macromedia Shockwave movies (p. 5 lines 10-13). However, the specification then states that these embodiments are merely exemplary and not limiting (p. 5 lines 10-13). The applicants are essentially saying that the client side logic is software. However, the application only describes generally the functions the client side logic performs but provides no details on the particular software constructs that would be used to implement those functions. The specification describes an embodiment of the CGI as being a servlet, but states that other embodiments are possible (p. 6 lines 3-4). Although the specification generally describes the functions of the CGI, the specification provides no guidance on the specific software constructs that would be used to implement those functions. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

Art Unit: 2142

As to existence of working examples, the specification does not describe a working example. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

After weighing all of the factors, the totality of the evidence suggests that it would require undue experimentation to make and use the claimed invention. The majority of the factors for which there is evidence suggest that undue experimentation is required. Furthermore, although a patent need not teach, and preferably omits, what is well known in the art, *in re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies*, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984), the corollary to this statement is that a patent discloses more detail concerning the features that distinguish the claimed invention from the prior art. In this regard, the specification's lack of direction, which is discussed above, appears critical. In addition, the need for more description is consistent with the statement of Robert Betros, one of the inventors of the claimed invention, in the telephone interview on June 15, 2006, where he argued that the client side logic and CGI allow for the performing of two-way asynchronous communication.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/25/06

KYL



ANDREW CALDWELL
SUPPLY PATENT EXAMINER